

### **REMARKS**

Reconsideration is respectfully requested.

The specification has been amended on page 6 to correct an improper reference number designation. Claims 1, 11 and 15 have been amended to specify in the body of each claim that the “on-line user” is an “on-line data network user who has not pre-subscribed for automated data network call notification service.”

In the Office Action, Claims 1-24 were again rejected under 35 U.S.C. 103 as being unpatentable over Devillier et al (US Pat No. 6,366,661) in view of Bansal et al. (US Pat No. 6,208, 726). The grounds for rejection are the same as those set forth in the first Office Action. In regard to the patentability arguments raised in applicant’s previously-filed response to that action, the Office makes two points. One is that the limitation of “an on-line data network user who has not pre-subscribed for automated data network call notification service” cannot be given patentable weight because it appears only in the preamble. The present amendment addresses this concern by incorporating the limitation into the body of independent claims 1, 11 and 15.

The second point raised in response to applicant’s previous patentability arguments is that there is no showing in Devillier that “the feature of notification service is required to be subscribed by a communication user.” Instead, the Office argues, Devillier’s uses the term “subscriber” to mean that the person being notified of a call is a subscriber of basic telephone or data network service. Applicant respectfully traverses.

It is well settled that a prior art reference must expressly or inherently disclose the feature that the reference is being relied on to teach. MPEP 2144.01. In the present case, Applicant can find no express disclosure in Devillier that defines “subscriber” the way the Office has defined it. Such a meaning is not set forth anywhere in Devillier, and is not supported by a fair reading of

that reference. On the contrary, it is stated at column 3, lines 57-58 of Devillier that the “subscriber” is “[a] subscriber who employs the routing system described herein . . . .” This statement appears to expressly support applicant’s interpretation of DeVillier as disclosing a system where a pre-subscription to automated data network call notification service is required.

There also appears to be no inherent disclosure in DeVillier that supports the proposition that the “subscribers” mentioned in that reference are persons who merely subscribe to telephone or Internet service. A finding of inherency must be based on inferences which one skilled in the art would reasonably be expected to draw from a reference. MPEP 2144.01. It is submitted that applicant’s interpretation of “subscriber,” i.e., someone who subscribes to automated data network call notification service, is the one that would be understood by persons skilled in the art who read the DeVillier reference. In contrast, persons skilled in the art would not be likely to assume that DeVillier is proposing a free service that does not require pre-subscription, and that the “subscribers” referred to by DeVillier are merely ordinary telephone or Internet subscribers. Pursuant to MPEP 2144.03, applicant hereby traverses any interpretation of DeVillier which may be based on knowledge or information not contained in that reference, and requests that an affidavit be provided to support such knowledge or information, to the extent it forms part of the present rejection. In particular, it appears that it is the Office’s burden to offer affidavit evidence demonstrating that its interpretation of “subscriber,” as used in DeVillier, is the correct one.

Applicant submits that once DeVillier is properly interpreted as a reference that involves subscribers who must pre-subscribe for automated data network call notification service, the patentability of the present invention becomes apparent. As set forth in the response to the first Office Action, the cited references represent the state of the prior art as discussed in the “Background” section of the subject application. Devillier discloses conventional call

notification service for on-line data network users ("Internet call waiting") in which a data network user can receive notifications of incoming calls and can specify call treatment options. This service work fine for some regions of the world, but is not available in all countries. In particular, the service requires a terminating number (called party) based intelligent switching system and a pay subscription in which the data network user pre-registers for service. Bansal mentions conventional emergency call break through systems wherein an operator can connect into an existing telephone call to advise a party that a high priority caller is trying to get through. The caller incurs a special charge for this service. In many countries, operator assisted calling represents the premier resource for voice network call completion and billing services.

The present invention marries these two concepts such that a form of Internet call waiting is made available to data network subscribers without the need for terminating number based intelligent switching or pay subscriptions, and which is fully compatible with operator assisted calling. This is reflected in the independent claims, which specify that call notification is provided to an on-line data network user who has not pre-subscribed for automated data network call notification service and that prior to the call notification a charging strategy is established relative to the caller.

It would not have been obvious to modify Devillier to integrate the special charge aspect of Bansal so that Internet call waiting is provided with a charging strategy being worked out in advance. Because Devillier's notification system is a subscriber-based service, there would have been no motivation or incentive to provide for caller-side charge strategy establishment. In Devillier, the data network user/subscriber pays for all call notifications. It would be redundant to bill both the caller and the data network user for the same notification. The only way a charge would be issued to a caller taking advantage of Devillier's service is if the service was somehow

modified to provide alternative charging options that would allow a subscriber to specify that he/she does not want to be billed for incoming notifications, and that callers are to be charged. This would be a very unlikely service scenario. Even assuming Devillier is modified so that callers are given a special charge, as in Bansal, this is not a charging strategy because no alternative charge options are given to the caller. In the subject application on page 9, an exemplary charging strategy is described that includes negotiation as to who pays for the notification (caller or data network user) and how the charge is to be paid (coin deposit, billing account, etc.). The references fail to disclose or suggest such a negotiation.

Accordingly, it is believed that the rejection of claims 1-24 is in error. Additional grounds for patentability are further found in several of the dependent claims, as follows:

Claims 6, 13 and 20 specify that a call alert query is issued without billing verification of said on-line user. This subject matter is not mentioned in either of the references. In Devillier, the on-line user is always a subscriber and thus billing verification must be performed. Bansal does not disclose call alert queries at all.

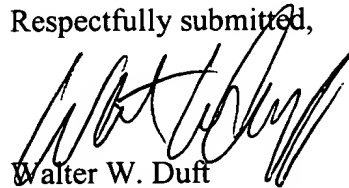
Claims 7, 14 and 21 specify that a call alert query is issued without subscriber verification of said on-line user. This subject matter is not mentioned in either of the references. In Devillier, the on-line user is always a subscriber and thus subscriber verification must be performed. Bansal does not disclose call alert queries at all.

In view of the foregoing, Applicant respectfully requests that the rejection be withdrawn and that Notices of Allowability and Allowance be duly issued.

A Petition for a one-month extension of time is enclosed herewith.

A Correspondence Address Change Notification is also enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Walter W. Duft', is written over the typed name.

Walter W. Duft  
Attorney for Applicant  
Registration No. 31,948

8616 Main Street, Suite 2  
Williamsville, New York 14221  
Telephone: (716) 633-1930